

REMARKS

Claims 1, 3-14, 32, 34-41, and 44-52 are pending in the present application, claims 2, 15-31, 33 and 42-43 having been cancelled without prejudice or disclaimer, and claims 49-52 having been added herein. The Office Action and cited references have been considered. Favorable reconsideration is respectfully requested.

Claims 1, 3-14, 24, 32 and 34-48 were rejected under 35 U.S.C. § 103 as being unpatentable over Hamilton (U.S. Patent No. 6,968,316) in view of Doerr (U.S. Patent No. 6,473,745). This rejection is respectfully traversed for the following reasons.

Claim 1 includes, *inter alia*, the feature: determining based on at least one criterion whether or not to evaluate said predetermined relationship, if the step of determining determines that said predetermined relationship is not to be evaluated, applying the step of determining to a next one of said at least one predetermined relationships or ending the analysis, if the step of determining determines that said predetermined relationship is to be evaluated, then for said predetermined relationship performing certain specific steps. The Examiner asserts that Doerr teaches this feature at col. 5, lines 17-39. Applicant respectfully disagrees.

The Examiner takes the position that Doerr's "trigger point to determine if advice is needed" corresponds to the claimed step of determining. However, col. 5, lines 49-51 state "it should be noted that trigger points are intentionally simple in nature, and, for example, do not make any judgement on whether to render advice." The advice engine 64 "is a body of code, separated into a DLL, that takes the information passed from the trigger points in the client application 60 and uses that and other information to compare the current state against the

engine's stored test conditions in order to determines [sic] what advice, if any, should be 'triggered.'" Thus, Doerr teaches one of ordinary skill in the art to use test conditions to determine which advice should be triggered at the particular point in the application in which the trigger point is inserted. It does not teach "determining based on at least one criterion whether or not to evaluate said predetermined relationship."

For at least this reason, Applicant submits that, even assuming for the sake of argument only, that one of ordinary skill in the art would have been motivated to combine the teachings of Hamilton and Doerr, the result would not have yielded the present claimed invention, since neither reference discloses determining, based on at least one criterion, whether to retain for or exclude from evaluation, said predetermined relationship as recited in claim 1.

Further, Applicant respectfully submits that only with impermissible hindsight reference to Applicant's disclosure, would one of ordinary skill been motivated to combine the teachings of these two patents. The Office Action concludes that it would have been obvious to combine the teachings of Hamilton with Doerr "to offer an improved system/method to customers." However, this is nothing more than a bare allegation of improvement, with no analysis as to why the modification would be an improvement. Further, there no rationale provided as to whether such modification would have had a reasonable expectation of success.

Applicant respectfully submits that since independent claim 1 is deemed new and inventive, all claims dependent on claim 1 are also deemed new and inventive. System claim 40 and Beauregard type claim 41 are also deemed new and inventive for the same reasons as stated for claim 1.

Claims 24, 42, and 43 have been cancelled without prejudice or disclaimer, thus rendering the rejection thereof moot.

Applicant respectfully submits that independent claim 38 is also new and inventive compared to Hamilton in view of Doerr. It is noted that a non-limiting example of one of the features recited in claim 38, namely the evaluation of a relationship which includes comparing magnitudes of determined values with one another, was recited in original claim 12. The Examiner now cites Hamilton, Table 3, col. 11, lines 34-40, and Doerr, col. 5, lines 17-20, against claim 12. However it is noted that the cited portion of Hamilton discusses the calculations that take place of financial values in response to activation of the processing of the report. The cited portion of Doerr discloses that trigger points are placed in the application where advice is needed. Neither of the cited patents disclose the combination of features recited in claim 38 such as relationship evaluation which includes comparing magnitudes of values with one another, choosing less than all of the variables based on the comparison, and selecting less than all of the paragraphs associated with the relationship for output based on the evaluation results, where the selected paragraph(s) are associated with the chosen variable(s). System claim 44 and Beauregard-type claim 45 are also deemed new and inventive for the same reasons as stated for claim 38.

Additionally, Applicant respectfully submits that independent claim 39 is new and inventive compared to Hamilton in view of Doerr. It is noted that claim 14 includes a non-limiting example of a feature of claim 39, where claim 14 recites an evaluation which includes verifying that values of all of said at least two linked variables have been evaluated. The

Examiner cited Figure 2, elements 300 to 500 against Claim 14. Applicant respectfully disagrees and submits that neither in these citations nor anywhere else in Hamilton's description of the invention, does Hamilton provide either a hint or indication of verifying that values of all of said at least two linked variables have been evaluated, as recited in claim 14. Certainly, therefore there is neither a hint nor an indication in Hamilton that an evaluation can include a decision on whether or not values of all linked variables have been determined, and that the method only proceeds to select paragraph(s) if the values of all linked variables have been determined, as recited in claim 39. System claim 46 and Beauregard-type claim 47 are also deemed new and inventive for the same reasons as stated for claim 39.

Claims 4, 49 and 51 recite that the at least one criterion is a test of significance of the relationship, and the step of determining based on at least one criterion determines that a relationship is not to be evaluated if a test of significance is not passed (the system claims recite that the filter is configured to output a determination that ...). The Examiner cites Doerr, col. 5, lines 17-21 as allegedly teaching that feature. Applicant respectfully disagrees. The cited portion states:

[i]n accordance with one aspect of the present invention, as shown in FIG. 3 and described in more detail below, at certain locations in the application program 60, trigger points (Trigger_[1] – Trigger_[n]) have been placed wherein advice is deemed likely to be needed.

However, this would be understood by one of ordinary skill in the art to disclose that in various places in the application program, trigger points were inserted by the designers of the program, which trigger points, when reached during execution of the program, would cause advice to be displayed (because it is needed or desirable). In contrast, the method according to the present

application involves determining based on a test of significance whether or not evaluation of a relationship is needed or desirable.

Claims 5, 50 and 52 recite that the at least one criterion is a user specified criteria, and the step of determining based on at least one criterion determines that a relationship is not to be evaluated if the user specified criteria are not fulfilled (the system claims recite that the filter is configured to output a determination that ...). The Examiner cites Doerr, col. 6, lines 34-57, Figure 3/element 64 "test condition") as allegedly teaching that feature. Applicant respectfully disagrees. The cited portion states:

To determine whether a condition is satisfied, the advice engine 64 may access the database 62 to find other state information such as the current application data 66. This typical action is generally represented by circled numerals 2 and 3 in FIG. 2. As a result, the application 60 does not have to pass all the state information to the advice engine 64, (and indeed may not pass any). It is also feasible to prompt the user at this time, such as if a piece of information needed for testing a condition was not otherwise available. In any event, with such gathered data and the information string passed thereto by the application 60, the advice engine 64 obtains the various state data parameters for testing the conditions. However, it should be noted that the application 60 and/or advice engine 64 may calculate and store some items in advance, particularly during idle times, so that the user does not notice a decline in perceived performance when a trigger point is reached. For example, rather than have the advice engine access the database 62 each time to sum the various sources of income to use in the debt-to-income ratio calculation, the sources of income may be pre-totaled and/or buffered in a higher-speed storage by the application 60 or the advice engine 64. Similarly, the total debt, and even the user's actual ratio itself may be pre-computed for rapid access by the advice engine 64.

One of ordinary skill in the art, when reading this passage in light of the remainder of the patent, would understand that the test conditions for which input is being sought does not correspond to Applicant's claimed user specified criterion for determining whether a particular relationship is

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to be evaluated. According to Applicant's claimed invention, the user can shape what goes into the report by specifying that certain relationships are not to be evaluated (*i.e.*, the user specified criteria are not fulfilled). This ability is not present in Doerr.

For at least these reasons, Applicant respectfully submits that claims 1, 3-14, 32, 34-41, 44-52 are patentable over the prior art of record.

In view of the above amendment and remarks, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections of record. Applicant submits that the application is in condition for allowance and early notice to this effect is most earnestly solicited.

If the Examiner has any questions, he is invited to contact the undersigned at 202-628-5197.

Respectfully submitted,

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